

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

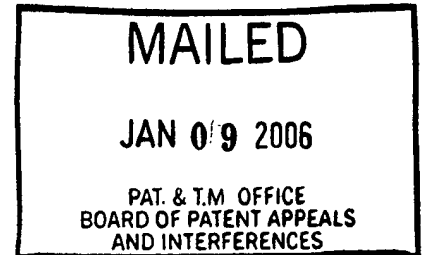
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. CORDERY, KARIN A. RUSSO
and RONALD P. SANSONE

Appeal No. 2006-0073
Application 09/683,381

ON BRIEF



Before THOMAS, DIXON, and MACDONALD, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 17.

Representative claim 1 is reproduced below:

1. A system of hazard detector systems for detecting hazards in a mail piece and notifying users including senders and recipients having quarantined mail comprising:

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a plurality of detectors each including a contaminant detection hazard detector for triggering a mail piece quarantine indication, an image scanner for scanning the face of a mail piece, a communications system, and a scan detection system for providing sender and recipient information for quarantined mail pieces; and

a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient.

The following references are relied on by the examiner:

Alden	2003/0072469 A1	Apr. 17, 2003 (Filed Oct. 17, 2001)
Yoon	2003/0136203 A1	Jul. 24, 2003 (Prov. App. Filed Oct. 26, 2001)

Claims 1 through 17 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness, the examiner relies upon Yoon in view of Alden.¹

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for the appellants' positions and to answer for the examiner's positions.

¹An outstanding rejection of claim 16 under the second paragraph of 35 U.S.C. § 112 appears to be withdrawn. This rejection is not repeated in the answer and the bottom of page 2 of the answer states that this rejection is not an issue in the present appeal in addition to the comment at the middle of page 20 of the answer that the examiner considers the rejection to be moot.

OPINION

We reverse the outstanding rejection of all claims on appeal under 35 U.S.C. § 103.

At the top of page 6 of the principal brief on appeal, appellants make note that the examiner relies upon the filing date of the provisional patent application of the Yoon patent publication yet fails to provide a copy of the provisional application to support such an entitlement. The actual filing date of the Yoon patent publication is October 28, 2002, which by itself is after the filing date of the present application of December 19, 2001. Priority, however, of Yoon is based upon the provisional application 60/344,635, filed on October 26, 2001.

In the responsive arguments portion of the answer beginning at page 16, the examiner notes that a copy of the provisional application was provided with the answer to appellants.

Appellants, in their reply brief, assert at pages 1 through 3 that the examiner is not entitled to rely upon the Yoon patent without support in the underlying provisional application, appellants indicating that the examiner's answer makes several references to the Yoon patent publication that have absolutely no support in the underlying provisional application. Appellants

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indicate at page 2 of the reply brief that the underlying provisional application does not support the statement in paragraph 0124 allegedly indicating that a quarantine action is undertaken. Additionally, appellants assert at page 3 of the reply brief that there is no corresponding support in the underlying provisional application to teach or even suggest external communication such as email.

The examiner's communication to appellants indicating the entry of the reply brief on January 7, 2005, contains no comments responding to these assertions in the reply brief, even though rule 37 CFR § 41.43(a)(1) permits the primary examiner to furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.


On the basis of the arguments and evidence before us, we must reverse the outstanding rejection of all claims on appeal. The examiner does not address appellants' arguments that the examiner is not entitled to the provisional application filing date for the features relied upon by the examiner in the statement of the rejection. The examiner has not indicated to us that the limitations argued are necessary to substantiate the rejection or/are otherwise taught or suggested in the provisional application or in Alden either for that matter.

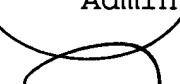
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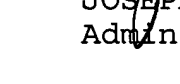
Without countervailing arguments and/or evidence to the contrary from the examiner, we are constrained to agree with appellants' assertions in the reply brief that Yoon is not available as prior art since the effective filing date of this patent publication does not apparently teach the features argued by the examiner.

In view of the foregoing, the decision of the examiner rejecting claims 1 through 17 on appeal under 35 U.S.C. § 103 is reversed.

REVERSED


JAMES D. THOMAS
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
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